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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,767	11/27/2001	Ming-Sum Fang	12283	7588
25763 7590 09/11/2008 DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT SUITE 1500 50 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402-1498				
			EXAMINER	
			AGWUMEZIE, CHARLES C	
			ART UNIT	PAPER NUMBER
			3685	
			MAIL DATE	DELIVERY MODE
			09/11/2008 PAPER	

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/993,767  
Filing Date: November 27, 2001  
Appellant(s): FANG ET AL.

\_\_\_\_\_  
Gary Abeley, Reg. No. 40,479  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed June 5, 2008 appealing from the Office action mailed September 4, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,234,389	VALLIANI	5-2001
6,963,908	LYNCH	11-2005
6,877,093	DESAI	4-2005

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

- 3                   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.                   Claims 1, 3-5, 7, 8, 10, 11, 13-17, 20-23, 25-27, 29, 30, 32, 33, 35-39, and 42-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai et al., U.S. Patent No. 6,877,093 in view of Valliani et al., U.S. Patent No. 6,234,389 and Lynch et al., U.S. Patent No. 6,963,908.

As per claims 1, 3-5, 7, 8, 10, 11, 13-17, 20-23, 25-27, 29, 30, 32, 33, 35-39, and 42-69, Desai et al. teach a method and system for downloading an application to a card terminal (figure 4) comprising:

- receiving a request from a remote network connection a request to download an application to a card terminal using a processing arrangement (figure 6; column/line 10/3-11/32; column 13, lines 5-10 and 30-40)
- using the processing arrangement (figure 6; column/line 10/3-11/32) monitoring a card terminal (column 13, lines 30-34) to detect

at least one activity (e.g. process a transaction or close a batch) performed at the card terminal and detecting the monitored activity downloading, by generating and transmitting a data stream over TCP/IP, the application to the card terminal wherein the terminal is reconfigured based on the application (figure 4; column 3, lines 4-11; column/line 6/66-7/24; column 10, lines 15-33; column/line

12/56-13/30; column 13, lines 30-34 and 38-66; column 14, lines 5-8)

- downloading an application to provide an indication of information to be printed on a receipt, audio information to be generated at card terminal or visual information to be displayed (column 3, lines 4-11; column 7, lines 24-37; column 8, lines 23-46; column 13, lines 6-29)
- transmitting a message to the card terminal relating to the triggering of the downloading of configuration data (column 9, lines 41-46; column/line 12/56-13/30)
- a processing arrangement comprising storage containing data related to card terminal configuration (figure 6; column/line 10/3-11/32; column/line 12/56-13/30)
- monitoring the terminal based on the request to re-configure the terminal (column 13, lines 30-34)

Desai et al. teach a user at a card terminal communicating with a web server over the Internet (e.g. dial-up, high-speed, etc.) (column/line 5/60-6/8; column 9, lines 42-46; column 10, lines 2-15) wherein the user and the server interact using a website (figure 8; column 12, lines 56-65) or GUI (column 9, lines 41-46).

Desai et al. do not teach detecting at least one activity such as a financial transaction at a card terminal and in response to the detection downloading an application to the terminal. Lynch et al. teach detecting a financial transaction (e.g. use of a credit card) at a terminal (e.g. PC, laptop, pda) (column 1, lines 18-27; column 9, lines 33-38; column 21, lines 15-20 and 27-38) and in response to the detecting of the transaction downloading a computer application to a terminal (column 9, lines 40-50). Lynch et al. also teach receiving from a remote network connection a request to download an application to a terminal using a processing arrangement (column 9, lines 12-30). However, Lynch et al. do not apply their system to card terminals. Valliani et al. teach a method and system for converting a terminal, such as a laptop or pda, into a point-of-sale terminal that includes a card reader (abstract). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Desai et al., Lynch et al. and Valliani et al. in order to allow a small business owner, such as a flea market vendor, to convert a laptop or pda to point-of-sale terminal ('389, abstract) and download associated software ('093, column/line 14/57-15/8; '389, column 2, lines 51-55; '908, column 4, lines 45-52) to facilitate card purchases without the need for a large dedicated

e-commerce infrastructure ('389, column 2, lines 8-37; '093, column 15, lines 47-58).

As per claims 5, 37 and 38, claims 5 and 37 recite "transmitting the information *upon* detecting a command..." (emphasis added). However, according to the MPEP (MPEP §2106 II C), language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (see also *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); *In re Collier*, 158 USPQ 266 (CCPA 1968); *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006)). Therefore, how Applicant's claimed method, for example, performs if a command is detected cannot differentiate the claims from the prior art.

As per claims 13 and 22, the type of information transmitted does not distinguish the claims from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01).

As per claim 21, claim 16 and 21, merely recite generating information "for display". Hence, as the configuration server of Desai et al. can format information for display (column/line 12/56-13/20) it continues to at least obviate Applicant's claimed method (MPEP 2114; *Ex parte Masham*, 2 USPQ2d 1647 (1987)).

**(10) Response to Argument**

*Claims 1, 8, 16, 30 and 38*

Initially, the Examiner would like to point out that the Appellant is arguing the art individually instead of what the combined art would have suggested to one of ordinary skill.

For example, Appellant identifies Desai as not teaching the limitation of:

Desai fails to teach, suggest or disclose the detection of at least one activity of a financial transaction, and based upon the detection, electronically transmitting to the card terminal information related to the request for use in downloading the application to the card terminal. (Appeal Brief, page 9, first full paragraph)

However, in order to teach this feature, the Examiner did not rely on Desai but Lynch. Therefore, as Lynch teaches detecting a financial transaction (e.g. use of a credit card) at a terminal (e.g. PC, laptop, pda) ('908, column 1, lines 18-27; column 9, lines 33-38; column 21, lines 15-20 and 27-38) and in response to the detecting of the transaction transmitting a computer application to a terminal ('908, column 9, lines 40-50), and Desai teaches transmitting a message (i.e. information related to the request for use in downloading the application to the card terminal) to the card terminal relating to the triggering of the downloading of configuration data ('093, column 9, lines 41-46; column/line 12/56-13/30) the combination of Desai, Valliani and Lynch teach the detection of at least one activity of a financial transaction, and based upon the



detection, electronically transmitting to the card terminal information related to the request for use in downloading the application to the card terminal. Similarly, Appellant argues that neither Lynch nor Valliani teach downloading computer applications to a card terminal (Appeal Brief, page 10, first full paragraph, lines 7-9, "Moreover...") and Valliani does not teach "... a remote network connection" (Appeal Brief, page 11, lines 1-2). Again, the Examiner did not rely on Lynch to teach card terminals, but to teach downloading computer applications to a computer ('908, column 9, lines 40-50) while Desai ('093, figure 6; column/line 10/3-11/32; column 13, lines 5-10 and 30-40), Valliani, on the other hand, is directed to converting a PDA or Laptop computer to a card terminal ('389, abstract). Regarding, "network connections", this is taught by Desai ('093, figure 6; column/line 10/3-11/32; column 13, lines 5-10 and 30-40). Hence, whether or not Valliani teaches this feature is moot and has no bearing on the validity of the rejection.

It has been held that in order to show nonobviousness one cannot attack the references individually when the rejections are based on combinations of references (*In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)). Therefore, Appellant's analysis is improper and it would have been obvious to combine Desai et al., Lynch et al. and Valliani et al. in order to allow a small business owner, such as a flea market vendor, to convert a laptop or pda to point-of-sale terminal ('389, abstract) and download associated software ('093, column/line 14/57-15/8; '389, column 2, lines 51-55; '908, column 4, lines 45-52) to facilitate card purchases without the need for a large dedicated e-

commerce infrastructure ('389, column 2, lines 8-37; '093, column 15, lines 47-58).

*Claims 8 and 30*

In order to overcome the rejection to claims 8 and 30 Appellant continues to rely on the strategy of selectively attacking references.

For example, in the second paragraph of page 14, Appellant states,

Lynch does *not* teach or suggest a system or method which relates to **electronically transmitting configuration data to the card terminal in order to reconfigure the card terminal**

However, this feature is taught by the combination of Desai, Lynch and Valliani.

Desai teaches downloading a computer application (column 3, lines 4-11; column 7, lines 24-37; column 8, lines 23-46; column 13, lines 6-29) to a card terminal in order to configuring card terminals ('093, figure 6, column/line 10/3-11/32; column 12/56-13/30). Therefore, whether or not this feature is taught by Lynch is moot. More specifically, Desai teaches a merchant updating software on a card terminal by electronically downloading configuration data to the terminals ('093, column 12/56-13/30). Desai does not explicitly disclose the merchant paying for such a service. Lynch provides a teaching for paying for computer applications ('908, column 1, lines 18-27; column 9, lines 33-50; column 21, lines 15-20 and 27-38) and in response to the detecting of the transaction transmitting a computer application to a terminal ('908, column 9, lines 40-50). In view of Desai and Lynch, a valid question could be asked- why would the card terminals of Desai be used to pay to update themselves? In other

words, in order to update an POS at a retail store, would the merchant make a payment using the same POS. Valliani, provides the answer. Valliani teaches a method and system for converting a computer such as a laptop or PDA into a card terminal ('389, abstract). Subsequent to such a conversion, at a later date, a predictable result (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)) would be to update the now laptop/card terminal ('389, figures 2-7) with new configuration information ('093, column 8, lines 23-45) and to pay for it using the "laptop" portion of the laptop/card terminal to access a website ('093, column 4, lines 5-10; '908, column 9, lines 13-40) by entering credit card data ('908, column 9, lines 13-40). Further, support for such analysis is not only suggested by the prior art but also taught as both Desai and Valliani are directed to non-traditional venues for card transactions such as a cab, a library or a person's home ('389, column 2, lines 8-37, column/line 5/64-6/8; '093, column 8, lines 8-45, column 15, lines 47-58) and for converting portable computers, such as laptops, into card transaction terminals for processing transactions made at said venues. Hence, the combined prior art teaches Appellant's claims.

*Claims 5 and 38*

As per claims 5 and 38, the Examiner reiterates his analysis that language that suggest or makes optional but does not require steps to be performed or does not limit a claim particular structure does not limit the scope of a claim or claim limitation (MPEP 2106 II C). Therefore, how Applicant's system operates "...upon detecting a command..." (emphasis added) will not differentiate the claims from the prior art.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Charlie C Agwumezie/  
Examiner, Art Unit 3685  
September 9, 2008

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